

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES
(APJ Richard Torczon)

DAVID T.N. WILLIAMSON,

Junior Party,

v.

FYI

OCT 09 1997

JEROME H. LEMELSON,

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BOX INTERFERENCE

Senior Party.

Patent Interference No. 103,800

LEMELSON'S RULE 635 MOTION No. 2

(RESTORATION OF JURISDICTION TO
THE EXAMINER FOR A LIMITED PURPOSE)

Filed on behalf of Party Lemelson
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Pursuant to 37 C.F.R. 1.635 and 1.614(c), Senior Party Lemelson ("Lemelson") moves for restoration of jurisdiction over Lemelson's involved application to the examiner for the limited purpose of entering amendments to the specification.

I. STATEMENT OF MATERIAL FACTS

1. This month, while reviewing a copy of the application received from the Dissemination Support Division of the Patent Office, counsel for Lemelson discovered that a number of amendments to application and the claims were never entered, or were incorrectly entered, by the Patent Office.

2. On May 13, 1987, Lemelson filed a preliminary amendment with his application. The preliminary amendment amended the "Related Applications" section of the original specification. (See May 13, 1987 Preliminary Amendment at pp. 1-2 and May 13, 1987 Declaration for Substitute Written Disclosure at p. 1.) This amendment contained several errors concerning the exact relationship between some parent applications. The Office's docket clerk placed the notation "A1" next to this amendment.

3. On August 16, 1991, Lemelson filed a supplemental amendment that corrected the errors in the "Related Applications" section of the substitute specification. (See August 16, 1991 Supplemental Amendment at pp. 2-3.). The Office docket clerk placed no notation next to this amendment.

4. The docket clerk crossed out the "Related Applications" section of the substitute specification and placed the notation "sub A1" next to it. Therefore, it appears that the "Related Applications" section was amended using the erroneous information

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from the May 13, 1987 preliminary amendment. (See Substitute Specification at p. 2 and May 13, 1987 Preliminary Amendment at pp. 1-2.) There is no indication that the corrected information from the August 16, 1991 Supplemental Amendment was entered.

5. The May 13, 1987 Preliminary Amendment also added the copied claims that are the subject of this interference. The docket clerk has placed the notation "a2" next to this amendment. (See Preliminary Amendment at pp. 17-32.) The docket clerk has placed the notations "add a1 B1" and "add E7" after the claims in the original specification. (See Original Specification after claim 9.) No notations occur after the substitute specification. It appears as if the docket clerk indicated amendment of the claims by adding the erroneous information regarding Related Applications ("A1") instead of adding the claims that are the subject of this interference ("a2").

6. On December 13, 1995, Lemelson filed a supplemental amendment to correct a typographical error by changing the term "includes" to --include-. Applicant inadvertently misidentified the location of this change and the correction apparently was not entered.¹ The correct location of this change is page 12 at line 26 of the substitute specification.

¹ This paper also contained an insert (labeled D1 by the Office), which the Examiner correctly entered after page 42, line 21 of the Substitute Specification. The electronic copy of the specification filed in this interference on August 10, 1998 incorrectly states that the text should have been inserted after page 42, line 2 of the Substitute Specification. However, the correct place is line 21, so no change is needed in the file wrapper. This paper also contained an erroneous amendment to change the word "racks" to --tracks-. No such amendment is required to the substitute specification in the involved application.

7. On August 7, 1996, Lemelson filed a Supplemental Amendment canceling claims 29 through 79. There is no indication that this amendment was entered.

8. During creation of an electronic copy of the involved specification, seven additional typographical errors were discovered. These typographical errors are noted in footnotes of the electronic copy (filed August 10, 1998).

II. REASONS WHY THE REQUESTED RELIEF SHOULD BE GRANTED

"An administrative patent judge may for a limited purpose restore jurisdiction to the examiner over any application involved in the interference." 37 C.F.R. §1.614(c).

First, counsel for Lemelson filed a preliminary amendment over ten years ago that added the claims that are the subject of this interference. However, it appears that this amendment was not properly entered by the Office. It is not clear that this interference can continue or was even properly declared without the Office having entered this amendment.

Second, Lemelson filed an amendment canceling the non-interfering claims from this application over two years ago, but counsel could find no indication that the Office entered the amendment. Lemelson should not be penalized, and Williamson should not gain an advantage, through a clerical error of the Office.

Third, Lemelson filed an amendment over seven years ago to correct the lineage of the involved application, but that amendment was not entered. Lemelson intends to show that a number of the parent applications support the claims in interference. However, the specification as currently amended incorrectly specifies the exact relationship between

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several of Mr. Lemelson's parent applications. Again, Lemelson should not be penalized, and Williamson should not gain an advantage, through a clerical error of the Office.

Because Lemelson may be prejudiced by the failure of the Office to properly enter these amendments, jurisdiction for the involved application should be restored to the Examiner for the limited purpose of entering these amendments to the specification.

While jurisdiction is returned to the Examiner for this limited purpose, it would be efficient to amend the seven typographical errors that Lemelson's counsel recently noted in the electronic copy of the specification.

III. CONCLUSION

Jurisdiction over Lemelson's involved application should be restored to the Examiner for the limited purpose of entering the amendments filed prior to the declaration of this Interference and to correct the seven additional typographical errors. In the alternative, Lemelson requests that the Board correct these problems, without remand.

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Counsel for Lemelson has met and conferred with counsel for Williamson in an effort in good faith to resolve by agreement the issues raised by the motion. Counsel for Williamson has indicated that Williamson does not currently have enough information to determine whether it will oppose this motion.

Respectfully submitted,

Lemelson Medical, Education & Research
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by its attorney



Dated: October 9, 1998

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I hereby certify that a copy of this paper
is being deposited in an envelope as
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this 9th day of October, 1998, to:

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